

REMARKS

Reconsideration of the instant Office Action, entry of the amendments submitted herewith and allowance of all pending claims are respectfully requested.

In the instant Office Action, claims 1-43 are listed as pending, claims 2-8 and 10-43 are withdrawn from consideration and claims 1, 9 and 11 are listed as rejected.

Both the Abstract and claim 1 have been amended in response to the instant Office Action.

Applicants state that the amendment of claim 1 does not introduce new matter and that the aforementioned amendment does not require any amendment of inventorship pursuant to 37 C.F.R. 1.48(b).

1. At page 2 of the instant Action, the Examiner maintains the restriction requirement imposed in the Office Action mailed 14 September 2004. Applicants acknowledge the Examiner's comments. To preserve the record in the event that an appeal is filed, Applicants resubmit and incorporate by reference their argument against the propriety of the restriction requirement submitted 9 December 2004, however, in an effort to advance the prosecution of the instant application to grant, Applicants agree to the withdrawal of claims 2-8 and 10-43 from consideration at this time. Applicants reserve the right to pursue any withdrawn subject matter in future applications.

Applicants note that dependent claims 2-21, composition claim 30 and method claims 31 – 36 are subject to rejoinder upon the allowance of product claims 1, 9 or 11 as provided for in MPEP §809. Applicants submit that claims 2-21 and 30-36 currently incorporate the limitation of claim 1 by the language "a compound according to claim 1."

2. Claim 1 stands provisionally rejected under 35 U.S.C. § 101 as being an exact, letter-to-letter duplication of claim 1 of co-pending application serial no. 10/33,556. Applicant contend that the above amendment of claim 1 obviates the double patenting rejection since claim 1 is no longer identical to claim 1 of the co-pending application.

Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §101.

3. Claims 1, 9 and 11 stand rejected under 35 U.S.C. §112, first paragraph, for not meeting the enablement requirements. In particular, the Examiner holds that the Applicants failed to provide a sufficient teaching in the specification to make prodrugs of the claimed

compounds. Without conceding the correctness of this rejection and in an effort solely to advance the prosecution of the pending application to grant, claim the objectionable phrase “and prodrugs thereof or a pharmaceutically acceptable salt” has been deleted from claim 1.

Applicants contend that this amendment obviates the rejection.

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 9 and 11 under 35 U.S.C. §112, first paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

4. Claims 1, 9 and 11 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which [the Applicants] regard as the invention. In particular, the Examiner objects to Applicants claiming prodrugs of the novel compounds. Without conceding the correctness of the Examiner’s reasoning, Applicants have amended claim 1 to delete all references to prodrugs. As such the rejection of claim 1 under 35 U.S.C. §112, second paragraph, is obviated.

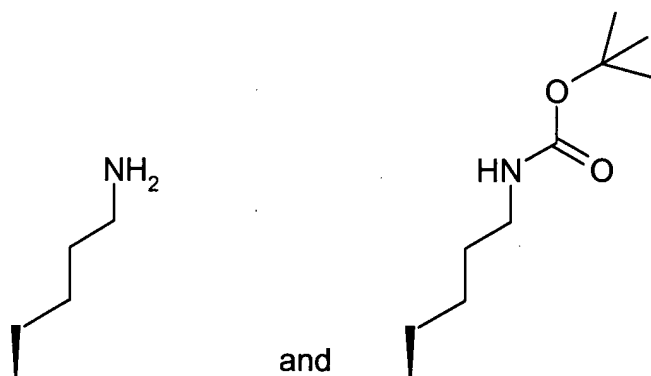
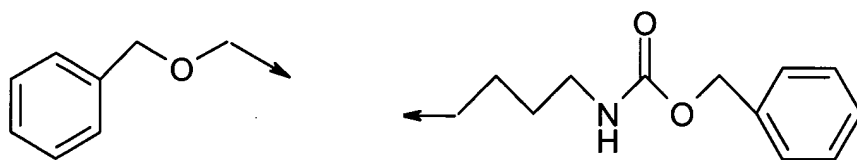
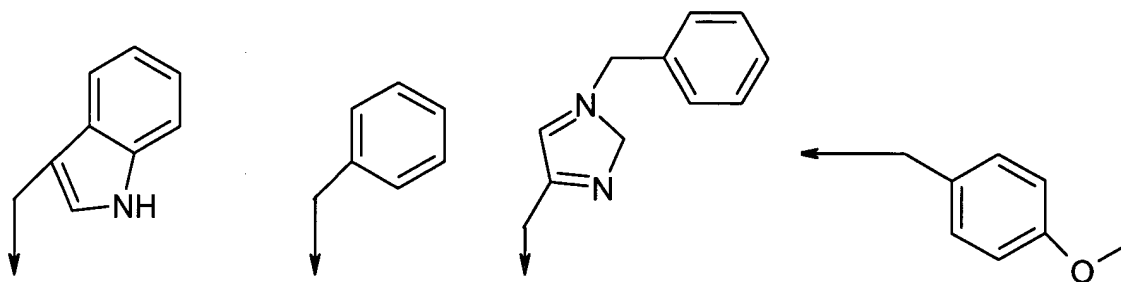
Claim 1 has been rejected for use of “C₀alkyl” as recited in the definitions of R⁵ and R⁵. Applicants submit that one skilled in the art would recognize that use of 0 as a subscript indicated that the alkyl groups found in the recited moiety may be absent. In an effort to advance the prosecution of the application to grant, Applicants have amended claim 1 by replacing “(C₀-C₆)alkyl” with “[C₁-C₆]alkyl]_p” which is more consistent with other instances in the instant application when a moiety is not present. Applicants have also amended claim 1 to recite that “p” is either 0 or 1. Applicants contend that this amendment does not introduce new matter.

The *proviso* clause of claim identified as “(c)” has been amended to delete “H or”.

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 9 and 11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

5. Claim 1 stand rejected under 35 U.S.C. §§ 102(a) and (e) as being anticipated by U.S. Patent 5,733,882 issued to Carr. Without conceding the correctness of the Examiner’s position, Applicants have amended claim 1, by appending a new *proviso* clause to claim 1, requiring that at least one “m” in the definition of R³ must not be 0. This amendment is

consistent with the examples provided in the specification. Applicants note that of the 2,057 or so examples disclosed in the specification, only the following eight moieties are found at R³:



Applicants note that for each of the above examples, at least one alkyl group separates the aryl or heterogroup from the remainder of the molecule. As such, the requirement that at least one *m* in the definition of R³ can not be 0, is supported by the disclosure and does not introduce new

matter. As noted by the Examiner, the Carr compound reads on claim 1 of the instant application only when “both m are 0” in R^3 . The new *proviso* clause appended to claim 1 does not provide for this occurrence, and as such, U.S. 5,733,882 does not anticipate claim 1 as amended.

Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §§ 102(a) and (e) as being anticipated by U.S. Patent 5,733,882 issued to Carr.

6. Claim 1 stand rejected under 35 U.S.C. §§ 102(b) as being anticipated by French Patent 2.132.632 issued to Bornowski and Herzig. Without conceding the correctness of the Examiner’s position, Applicants note that the amendment of claim 1 to requiring that at least one m in the definition of R^3 must not be 0, obviates this rejection since the overlapping Bornowski *et al.* compound also requires that each occurrence of m in the definition of R^3 be 0. The argument proffered with respect to the applicability of the Carr patent also applies to the relevance of the Bornowski *et al.* patent, as well.

Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §§ 102(b) as being anticipated by French Patent 2.132.632 issued to Bornowski *et al.*

7. At page 12 of the instant Office Action, the Examiner objects to the Abstract for not containing the structural formula of the claimed compounds. In response thereto, Applicants have amended the Abstract, to include formula (I) as found on page 2 of the application. Applicants respectfully request the withdrawal of the objection to the Abstract and request entry of the amended Abstract.

In compliance with 37 C.F.R. § 1.72, a replacement Abstract is attached to this Reply as Exhibit “A”.

8. Applicants advise the Examiner that documents D, P, W, X, Y and Z, which were inadvertently not included with the Information Disclosure Statement submitted 9 September 2004, were previously provided to the Examiner on February 3, 2005, together with a detailed explanation of the reasoning for not providing copies of references Q and U.

9. Applicants are grateful for the conditional allowance of claims 9 and 11. Applicants, however, have not amended claims 9 and 11 in independent form including all of the limitations of the base claim and any intervening claims, as directed by the Examiner, in

anticipation that base claim 1 has been successfully amended to overcome the rejections thereof. Applicants respectfully request a subsequent opportunity to amend claims 9 and 11, as suggested by the examiner, in response to a later Office Action or if the rejection of claim 1, as amended above, is maintained.

10. Applicants acknowledge the Examiner's determination that von Geldern et al., "Azole Endothelial Antagonists, 1. A Receptor Model Explains an Unusual Structure Activity Profile," Journal of Medicinal Chemistry, (1996), 39(4):957-67, is the closest prior art with respect to claims 9 and 11.

CONCLUSION

Applicants submit that each ground for rejection asserted by the Examiner in the instant Office Action has been removed. On this basis, it is submitted that claims 1, 9 and 11 are now in a condition for allowance. Applicants further request the rejoinder of claims 30-43 withdrawn in response to the restriction requirement.

Prompt and favorable action is solicited.

Should Examiner Tucker deem that any further action be desirable with respect to these matters, she is requested to telephone the Applicants' undersigned representative.

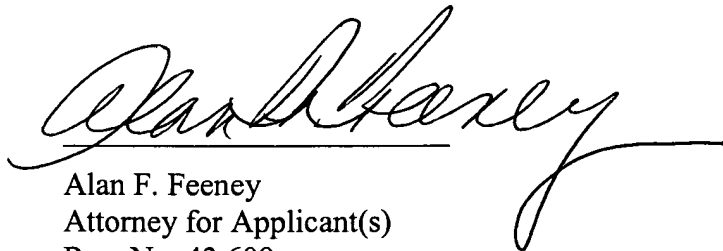
The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0590.

Respectfully submitted,

Date:

7/13/2005

IPSEN (Biomeasure)
27 Maple Street
Milford, MA 01757-3650
(508) 478-0144 Telephone
(508) 473-3531 Facsimile


Alan F. Feeney
Attorney for Applicant(s)
Reg. No. 43,609